REMARKS

Claims 1, 3-4, 6, 8-13, 15-18, 20-23, 25-26, 28, 30-31, 33-35, 37-39 and 41-43 are pending in the application.

Claims 2, 5, 7, 14, 19, 24, 27, 29, 36 and 40 are withdrawn.

Claims 1, 3-4, 6, 8-13, 18, 20-23, 25-26, 28, 30-31, 33-35, 39 and 41-43 are rejected.

Claims 15-17 and 37-38 are objected to.

Claims 1, 16 and 23 are amended, claims 15, 17, 32 and 37-38 are canceled, and claims 44-45 are added.

Reconsideration and allowance of claims 1, 3-4, 6, 8-13, 16, 18, 20-23, 25-26, 28, 30-31, 33-35, 39 and 41-45 is respectfully requested in view of the following:

Responses to Rejections to Claims – 35 U.S.C. §103

Claims 1, 3, 8-13, 18, 20-23, 25, 30-31, 33-35, 39 and 41-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Skinner et al (U.S. Patent 6,901,276) (Skinner) in view of "Wi-Fi Networking News" (Rudis). Claims 4 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Skinner in view of Rudis and Critz et al (U.S. Patent 7,079,830) (Critz). Claims 6 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Skinner in view of Rudis and Lee (U.S. Publication 2004/0097257). These rejections are not applicable to the amended claims.

Claims 15-17 and 37-38 are objected to and indicated as allowable if rewritten in independent form including all the recitations of the base claim and any intervening claims. As such, independent claims 1 and 23 are amended and claims 44-45 are added to overcome the objection and are submitted to be allowable.

Thus, claims 1, 23 and 44-45 include:

Claim 1

> powering up a wireless section of an IHS to detect a presence of a wireless network while a system processor remains in a reduced power state; providing an indication to a user that a wireless network is present with which the IHS can communicate; and storing profile information in a memory accessible to the wireless section while the system processor remains in the reduced power state.

Claim 23

> a system processor; a memory coupled to the system processor; a wireless section, coupled to the system processor, which is powered up to detect the presence of a wireless network external to the IHS while the system processor

remains in a reduced power state; and an indicator, coupled to the wireless section, to provide an indication to a user that a wireless network is present with which the IHS can communicate, wherein the wireless section includes a memory in which profile information is stored while the system processor remains in the reduced power state.

Claim 44

powering up a wireless section of an IHS to detect a presence of a wireless network while a system processor remains in a reduced power state; providing an indication to a user that a wireless network is present with which the IHS can communicate; and while the system processor remains in the reduced power state, determining if a detected network matches a network included in a profile stored in the memory accessible to the wireless section.

Claim 45

a system processor; a memory coupled to the system processor; a wireless section, coupled to the system processor, which is powered up to detect the presence of a wireless network external to the IHS while the system processor remains in a reduced power state; and an indicator, coupled to the wireless section, to provide an indication to a user that a wireless network is present with which the IHS can communicate, wherein the wireless section determines if a detected network matches a network included in the profile information while the system processor remains in the reduced power state.

Furthermore, claims 1, 23 and 44-45 and their respective dependent claims are submitted to be allowable for the following reasons:

As the PTO recognizes in MPEP §2142:

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

The USPTO clearly cannot establish a *prima facie* case of obviousness in connection with the amended claims for the following reasons.

35 U.S.C. §103(a) provides that:

[a] patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains ... (emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, the references, alone, or in combination, do not teach the claims combinations.

Therefore, it is impossible to render the subject matter of the claims as a whole obvious based on a single reference or any combination of the references, and the above explicit terms of the statute cannot be met. As a result, the USPTO's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to the claims, and a rejection under 35 U.S.C. §103(a) is not applicable.

There is still another compelling, and mutually exclusive, reason why the references cannot be combined and applied to reject the claims under 35 U.S.C. §103(a).

The PTO also provides in MPEP §2142:

> [T]he Examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the Examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. ...[I]mpermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

Here, the references do not teach, or even suggest, the desirability of the combination because neither teaches nor suggests the claimed combinations.

Thus, neither of these references provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103(a) rejection of the claims.

In this context, the MPEP further provides at §2143.01:

> The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. (emphasis in original)

In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. In the present case it is clear that the USPTO's combination arises solely from hindsight based on the invention without any showing, suggestion, incentive or motivation in either reference for the combination as applied to the claims. Therefore, for this mutually exclusive reason, the USPTO's burden of

factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to the claims, and the rejection under 35 U.S.C. §103(a) is not applicable.

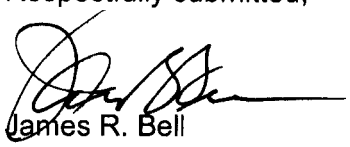
Therefore, independent claims 1, 23 and 44-45 and their respective dependent claims are submitted to be allowable.

In view of all of the above, the allowance of claims 1, 3-4, 6, 8-13, 16, 18, 20-23, 25-26, 28, 30-31, 33-35, 39 and 41-45 is respectfully requested.

The amended claims are supported by the original application.

The Examiner is invited to call the undersigned at the below-listed telephone number if a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,



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